

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte AKIHIRO IINO, MASAO KASUGA, and KENJI SUZUKI

Appeal No. 2002-0055
Application No. 09/290,046

ON BRIEF

Before HAIRSTON, KRASS, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

A patent examiner rejected claims 1-4, 6-14, 22-32, and 35-51. The appellants appeal therefrom under 35 U.S.C. § 134(a). We remand.

"The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the [B]oard [of Patent Appeals and Interferences] to examine the application and resolve patentability in the first instance." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999). In an *ex parte* appeal, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Here, after

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considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Braeken*, 54 USPQ2d at 1112. Our opinion addresses the following reasons for remanding:

- lack of specificity
- multiplied references
- new arguments.

A. Lack of Specificity

"For each rejection under 35 U.S.C. 103, the examiner's answer . . . shall . . . state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied upon in the rejection. . . ." M.P.E.P. § 1208 (8th ed., rev. 1 Feb. 2003).

Here, the examiner fails to point out where each of the specific limitations recited in the rejected claims is found in the prior art upon which he relies. In rejecting claims 1-4, 22-32 and 48-51 under § 103(a) as obvious over either U.S. Patent No. 5,001,404 ("Kataoka") or U.S. Patent No. 5,198,714 ("Salomon") in view of either U.S. Patent No. 5,780,955 ("Iino I") or U.S. Patent No. 6,064,138 ("Iino II"), for example, the examiner generally alleges that "Kataoka and Saloman [sic] teach a vibration motor using polarized piezoelectric material for drive and detection electrodes." (Examiner's Answer at 3.) In rejecting claims 6-14 and 33-47 under § 103(a) as obvious over U.S.

Patent No. 5,763,981 ("Okawazaki"); Iino I; and either U.S. Patent No. 5,406,160 ("Shirasaki") or U.S. Patent No. 5,438,229 ("Ohtsuchi"); moreover, he generally alleges that "Shirasaki and Ohtsuchi teach using feedback circuitry, including polarized piezoelectric detection electrodes to achieve frequency stability even drive force etc, etc." (*Id.* at 4.)

"We decline to substitute speculation as to the rejection[s] for the greater certainty which should come from the [examiner] in a more definite statement of the grounds of rejections." *Gambogi*, 62 USPQ2d 1209 at 1212. We ask the examiner to compare each of claims 1-4, 6-14, 22-32, and 35-51 "feature by feature with the prior art [references] relied on in the rejection." M.P.E.P. § 1208.¹ In particular, a mapping of each of the claimed features to a "specific page, line number, drawing reference number, and quotation from the prior art," *id.*, is needed for meaningful review.²

¹The appeal of the rejections evidences that "there are questions as to how limitations in the claims correspond to features in the prior art. . . ." M.P.E.P. § 1208

²The examiner issued five of the seven references on which he relies, viz., Kataoka, Salomon, Iino I, Shirasaki, and Ohtsuchi. The familiarity gained from examining these references may help him to identify specific line numbers and drawing elements corresponding to the claimed features.

B. Multiplied References

"The PTO Rules of Practice require the examiner to cite only what he considers the 'best references.'" *E.I. duPont de Nemours & Co. v. Berkley & Co.*, 620 F.2d 1247, 620 F.2d 1247, 1266-67, 205 USPQ 1, 16 (8th Cir. 1980). "The examiner is not called upon to cite *all* references that may be available, but only the 'best.'" M.P.E.P. § 904.03 (quoting 37 C.F.R. § 1.104(c)(2002)). See also M.P.E.P. § 706.02 ("Prior art rejections should ordinarily be confined strictly to the best available art.") "Multiplying references, any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution and should therefore be avoided." *Id.* at § 904.03.

Here, in rejecting claims 1-4, 22-32 and 48-51, the examiner alternatively cites lino I and lino II. (Examiner's Answer at 3.) In explaining the rejection, however, he applies both references for the **same** teaching, viz., "limo [sic] (138) and (955) teach it is advantageous to drive piezoelectric vibration motors with self-oscillation circuitry to yield stable operation and use less power." (*Id.* at 3-4.) Such an application evidences that each reference is as good as, but no better than, the other. Accordingly, we ask the examiner to limit the rejection of claims 1-4, 22-32 and 48-51 to either lino I or lino II,³ or to explain the differences necessitating the use of both references.

³For example, the examiner cites only lino I in rejecting of claims 6-14 and 33-47. (Examiner's Answer at 4.)

C. New Arguments

"Appellant may file a reply brief to an examiner's answer" 37 C.F.R. § 1.193(b)(1)(2003). "A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose." *Id.*

Here, the appellants filed a reply brief, (Paper No. 13), in response to the examiner's answer. They included new arguments therein. Specifically, the appellants argued, "[n]owhere in Kataoka and Salomon et al. is it disclosed or suggested that any of the detecting electrodes may be used to detect a drive signal having a drive frequency of the detecting electrode." (Reply Br. at 3.) More specifically, they argued that Kataoka's "detecting electrodes detect the amplitude of two-standing waves and a time difference between the two standing waves (see abstract.)" (*Id.*) The appellants similarly argued that Salomon's "detecting electrodes detect an amplitude and a time-phase difference between sensor voltage signals." (*Id.*)

Because the aforementioned arguments were filed in the reply brief, we do not have the benefit of a response from the examiner. Accordingly, we ask the examiner to respond to the new arguments.


CONCLUSION

For the aforementioned reasons, the application is remanded to the examiner for further action not inconsistent with the views expressed herein. Any supplemental answer submitted by the examiner should be self-contained with respect to all rejections and arguments. No prior answer should be referenced or incorporated therein. Similarly, any supplemental brief submitted by the appellants should be self-contained with respect to all arguments. No prior briefs should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).


KENNETH W. HAIRSTON
Administrative Patent Judge


ERROL A. KRASS
Administrative Patent Judge


LANCE LEONARD BARRY
Administrative Patent Judge

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